

Amendment

U.S. Patent Appl. Serial No. 09/652,793

REMARKS

Claims 3, 4, 8-14, 16-23 and 48-86 are pending in the subject application. Claims 3-23 and 48-54 have been examined and stand rejected. By the above amendments, claims 3, 9, 10, 12 and 23 have been amended, claims 5-7 and 15 have been canceled; and new claims 55-86 have been added. Favorable reconsideration of the application and allowance of all of the pending claims are respectfully requested in view of the above amendments and the following remarks.

As a preliminary matter, Applicant again notes that the present application is a continuation of U.S. Patent Application Serial No. 08/698,148, filed August 15, 1996, now U.S. Patent No. 6,199,045, as indicated in the Patent Application Bibliographic Data Sheet filed March 22, 2001.

The Examiner is again respectfully requested to acknowledge Applicant's claim to priority under 35 U.S.C. §120 in the next communication by checking box 15 on the Office Action Summary sheet (form PTO-326).

Claims 3-5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,025,261 to Ohta et al. in view of U.S. Patent No. 5,802,492 to DeLorme et al. Further, dependent claims 6-8 stand rejected in further view of U.S. Patent No. 5,365,451 to Wang et al., dependent claims 9-11 stand rejected in further view of U.S. Patent No. 5,930,729 to Khamis et al., dependent claims 12-22 stand rejected in further view of U.S. Patent No. 5,438,695 to Morimura et al., and dependent claim 23 stands rejected in further view of U.S. Patent No. 5,109,399 to Thompson. Applicant respectfully traverses these rejections for the following reasons.

All of these rejections were made in the Office Action dated August 23, 2002 (Paper No. 7). Applicant filed a response on November 25, 2002 in which none of these claims was amended and Applicant traversed all of these rejections, including nearly five pages of detailed arguments. In the present Office Action, the Examiner repeats all of these rejections verbatim, but does not respond at all to Applicant's detailed arguments. Instead, the Examiner merely states that Applicant's arguments with respect to claims 3-23 and 48-54 have been considered but are moot in view of the

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new ground(s) of rejection. **However, there is no new ground of rejection of any of claims 3-23 in the present Office Action.** MPEP 707.07(f) states that:

“Where the applicant traverses any rejection, the examiner should if he or she repeats the rejection, take notice of the applicant’s arguments and answer the substance of it.”

Applicant traversed the previous rejections of claims 3-23, and the Examiner repeated the rejections. However, the Examiner has not responded to Applicant’s arguments as required by MPEP 707.07(f). Accordingly, the Examiner is respectfully requested in the next communication to address Applicant’s arguments or allow these claims. For the Examiner’s convenience, the substance of these arguments is reproduced below. Applicant notes that certain amendments have been made to independent claim 3 and, for consistency, to dependent claims 9, 10, 12 and 23. However, these amendments have not been made in response to the rejections of these claims and do not materially alter the gist of Applicant’s arguments supporting traversal of the rejections.

Independent claim 3 sets forth a mobile communication device for use by a mobile user. The claimed mobile communication device includes: an input device that receives from an operator a selection signal indicative of a topic of interest; means for sending present position information and the selection signal over a bi-directional wireless link; and means for receiving position-related information that is a function of the present position information and the selection signal.

As the Examiner correctly acknowledges, Ohta fails to disclose an input device that receives from an operator a selection signal indicative of a topic of interest, as required by claim 3. Although not acknowledged by the Examiner, Ohta also fails to disclose or suggest means for sending both position information and the selection signal over a bi-directional wireless link and for receiving position-related information that is a function of both the position information and the selection signal, as required by claim 3.

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These differences between the claimed invention and Ohta are more fundamental than suggested by the Examiner's analysis. The system described by Ohta is simply a map displaying system. Position data is collected by Ohta's vehicle and transmitted to a remote key station that supplies related map data to the vehicle in return. Not only does Ohta lack an input device for receiving a selection signal indicative of a topic of interest; there is not the slightest suggestion in Ohta's disclosure to accept any sort of selection signal from a user or to receive position-related information from a remote server based on both position information and a topic selection signal. The map data accessed at Ohta's remote key station is retrieved based only on position data. Ohta does not disclose or suggest also transmitting a selection signal along with the position data, and then retrieving map data (or any kind of information) as a function of both position data and a selection signal indicative of a topic of interest.

The requirement of claim 3 of sending both position information and the selection signal over a bi-directional wireless link and receiving position-related information that is a function of both the position information and the selection signal is a fundamental aspect of the novelty of Applicant's claimed invention. In essence, the claimed device retrieves position-related information based on the combination of position information and a topic selection signal. There is not the slightest suggestion in Ohta's disclosure of how or why one would expand a map displaying system to be a fundamentally different type of system that permits selection of a topic of interest and then conveys information on that topic of interest as a function of user position and of the topic selection itself.

DeLorme does not make up for the deficiencies of Ohta, since DeLorme also fails to disclose or suggest sending position information and a selection signal indicative of a selected topic of interest over a bi-directional wireless link and receiving position-related information that is a function of the position information and the selection signal, as required by claim 3. DeLorme essentially discloses a desktop computer system that permits a user to engage in an iterative trip planning process in which a travel route can be prospectively determined or adjusted based on user-specified points of interest which lie along a travel route. Included among the various embodiments

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described by DeLorme is an in-vehicle embodiment in which a user can view the vehicle's current position and can also browse information about points of interest. DeLorme's system also includes a GPS interface capable of receiving position information from a GPS receiver. However, whether desktop or in-vehicle, the system of DeLorme involves retrieving information stored in the system. In particular, there is no suggestion in the description of DeLorme's in-vehicle embodiment of any means that sends position information and a selection signal indicative of a selected topic of interest over a wireless link or means that receives position-related information that is a function of the position information and the selection signal. Rather, the map and point of interest information is contained within DeLorme's device. Consequently, there is no need in DeLorme's system to send position information and a selection signal over a wireless link or to receive corresponding position-related information. This is an important and non-obvious advantage that the claimed invention has over systems such as DeLorme. By maintaining the position-related information remotely and indexing this information with the combination of the position information and the selection signal, the claimed invention avoids the need to maintain on-board databases of information and the corresponding problem of keeping such databases up to date. In any event, there is simply no teaching in DeLorme of any means that operates in the manner claimed.

Further, claim 3 requires that the position-related information be a function of both the position information and the topic selection signal. In contrast, the point of interest information accessed in DeLorme is not a function of position information indicative of the present position of the device. In DeLorme's desktop embodiment, the location of the desktop system is entirely irrelevant to the iterative trip planning process performed on the system. Even in DeLorme's in-vehicle embodiment, the selection and display of a point of interest is decoupled from the current position of the vehicle. For example, at column 18, lines 1-9, DeLorme explains that current position of the vehicle is displayed on a visual route map, while at the same time, a passenger can browse through places to eat in Seattle using a restaurant list box. As described, this restaurant list box is not retrieved as a function of the current position of the vehicle, but rather as a separate

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selection of the passenger, which selection can be independent of the current position of the vehicle (presumably, the passenger would be free to “browse” restaurant information in other locales). Thus, DeLorme does not suggest receiving position-related information as a function of both current position information and a selected topic of interest.

Since Ohta and DeLorme do not disclose or suggest any means for sending position information and a selection signal indicative of a selected topic of interest over a bi-directional wireless link or any means for receiving position-related information that is a function of the position information and the selection signal, the subject matter of claim 3 would not have been (and could not have been) obvious from any combination of these documents.

Moreover, Applicant respectfully submits that there is no obvious way to modify Ohta in view of DeLorme to meet the limitations of claim 3. Ohta is simply a map displaying system, wherein map data is retrieved from a remote key station. In order meet the limitations of claim 3, one would have to dramatically alter Ohta’s system to be something completely different. First, a user interface (together with supporting processing) would be required in order to present the user with the opportunity to select a topic of interest. Second, the selected topic of interest would need to be transmitted along with position information over a wireless link. Third, position-related information that is a function of both the position information and the topic selection signal would have to be received by the device. Of course, to support such modifications, one would also have to develop a remote support system that maintains extensive databases of information that can be accessed by the position information and the topic of interest selection signal. DeLorme could not possibly suggest all these modifications, since DeLorme’s system itself does not operate in this manner. More generally, Applicant respectfully submits that no reference could reasonably suggest modifying a map displaying system such as Ohta’s to be a position-related information retrieval system given the extensive differences between such systems. Only by use of impermissible hindsight could one reasonably conclude that Ohta could be modified to meet the requirements of

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claim 3. For all of the foregoing reasons, Applicant respectfully submits that claim 3 and its dependent claims 4 and 5 would not have been obvious over Ohta in view of DeLorme.

With regard to the rejections of dependent claims 6-23, Wang, Khamis, Morimura, and Thompson have been further cited for particular limitations found in certain dependent claims. However, like Ohta and DeLorme, none of these documents discloses or suggests any means for sending position information and a selection signal indicative of a selected topic of interest over a bi-directional wireless link and for receiving position-related information that is a function of the position information and the selection signal. Thus, no combination of these documents would have (or could have) rendered obvious the subject matter of parent claim 3, and dependent claims 4-23 should be patentable at least by virtue of their dependence on parent claim 3. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejections of claims 3-23.

Along with dependent claim 23 (23/3), independent claim 48 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ohta in view of DeLorme and Thompson. Applicant again traverses this rejection and respectfully requests that the Examiner respond to this traversal. As explained in the previous response and in a subsequent telephone conversation with the Examiner, this rejection appears to be in error. Unlike independent claim 3 and dependent claim 23, independent claim 48 requires, *inter alia*, a position reporting enabling unit configured to selectively enable and disable transmission of the position information while the mobile communication device is operational. There is no disclosure whatsoever of anything analogous to a position reporting enabling unit in Ohta, DeLorme and Thompson. The Examiner does not dispute this fact and again makes no mention of this claim limitation in the rejection. In fact, in paragraph 9 of the Office Action, the Examiner explicitly acknowledges that "In the above, it does not include the enabling, disabling the position reporting." Whether this acknowledgement applies only to Ohta or to DeLorme and Thompson as well is not clear. Nevertheless, there is no mention of anything analogous to the claimed position reporting enabling unit in any of these documents. Consequently, no combination of these documents could have rendered obvious the subject matter of claim 48.

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Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 48. **Applicant notes that claim 48 has not been amended; thus, if the Examiner asserts a new ground of rejection of claim 48 in a next office action, that office action cannot be made FINAL.** If the Examiner asserts this same ground of rejection in a next office action, the Examiner is respectfully requested to explain where in the cited references there is taught a position reporting enabling unit and reconcile this argument with the statement made in paragraph 9 of the present Office Action.

Dependent claims 49-53 (but not their parent claim 48) stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ohta in view of Delorme, Thompson, U.S. Patent No. 5,703,598 to Emmons, and U.S. Patent No. 5,479,482 to Grimes. Further dependent claim 54 (54/48) stands rejected as being unpatentable over Ohta in view of Delorme and U.S. Patent No. 5,774,827 to Smith, Jr. et al. Applicant respectfully traverses these rejections for the following reasons.

All of these claims inherently include the limitations of parent claim 48, which sets forth a mobile communication device for selectively reporting position information. The claimed mobile communication device requires: a receiver that receives position signals; a processor that determines the position information indicative of the present position of the mobile communication device from the position signals; a modulator/demodulator that transmits the position information to a destination over a communication network; and **a position reporting enabling unit configured to selectively enable and disable transmission of the position information while said mobile communication device is operational.**

As acknowledged by the Examiner, none of Ohta, DeLorme and Thompson discloses or suggests a position reporting enabling unit configured to selectively enable and disable transmission of the position information while the mobile communication device is operational, as required by these claims. Further, Applicant respectfully disagrees that, based upon Emmons disclosure, it would have been obvious to modify Ohta's system to include a position reporting enabling unit that

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selectively enables and disables transmission of position information. As previously summarized, Ohta discloses a navigation system wherein a mobile object reports its position to a remote key station that sends corresponding map data to the mobile object for display.

Emmons discloses a system for tracking stolen vehicles. The system of Emmons includes a GPS transmitter/receiver that can be activated only by reception of a remotely-transmitted coded signal (see Emmons, col. 1, lines 54-57; col. 2, lines 58-65). A local timer subsequently disables the GPS transmitter/receiver after a predetermined time. Importantly, since the GPS transmitter/receiver is onboard a stolen vehicle, the GPS transmitter/receiver cannot be enabled or even accessed locally. In fact, the GPS transmitter/receiver is purposely mounted in a location that is difficult to access.

Applicant respectfully submits that there is no meaningful or obvious way to combine Ohta and Emmons. At a general level, Ohta is an onboard mapping system, whereas Emmons is a stolen vehicle tracking system. While Ohta's system displays onboard map information, Emmons's system is designed to be hidden from the vehicle's passengers. These systems are so fundamentally different from each other that Emmons would not reasonably have suggested anything about modifying Ohta's system at the time the present invention was made without the use of impermissible hindsight.

More particularly, Emmons teaches remotely activating an onboard device for reporting position. Clearly, Emmons does not disclose and, in fact, teaches away from locally enabling an onboard device for reporting position (since this would require the thieves themselves to activate the device). Even assuming for the sake of argument that this teaching has relevance to Ohta, the resultant modification to Ohta would presumably be the capability to remotely activate Ohta's onboard mapping system and the exclusion of the capability to locally activate Ohta's onboard mapping system. This would not be an obvious modification to Ohta's system, since the onboard user of the mapping system would have no control over when the system was operational. While remote control of activation is desirable where the passengers have stolen the vehicle (as in Emmons), remote activation is not desirable for activating an onboard mapping system. Since it would not have been obvious to modify the system of Ohta in any reasonable manner based on the

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teachings of Emmons, the subject matter of parent claim 48, and hence rejected claims 49-52, would not have been obvious from these documents. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 49-52.

With particular regard to dependent claim 49, which requires a position reporting enabling unit that comprises an enable/disable switch on the mobile communication device, neither Ohta nor Emmons suggests such a switch. Again, as the Examiner acknowledges, Ohta does not suggest a position reporting enabling unit at all. Emmons teaches enabling position reporting from a remote location and explicitly teaches away from having a capability to enable position reporting from the mobile device itself (since control over activation and deactivation by the thieves is undesirable). Thus, for these additional reasons, the subject matter of dependent claim 49 would not have been obvious in view of the cited documents.

The Examiner now also cites Grimes in relation to dependent claim 49 for a teaching of a enable/disable switch, specifically equating a "location button 307" shown in Fig. 3 of Grimes with the claimed enable/disable switch. Contrary to the Examiner's assertion, however, Grimes' location button 307 does not operate as an enable/disable switch that selectively enables and disables transmission of position information, as required by claim 49. While the Examiner cites references to location button 307 at columns 13 and 16 of Grimes, the function and operation of location button 307 is actually quite clearly explained at column 6, line 66 - column 7, line 13 of Grimes. In particular, when an emergency call (e.g., a 911 call) is made from a cellular terminal 133 to a cellular switching system 134, the cellular terminal attempts to transmit the geo-coordinates (determined by GPS device 302) to the cellular switching system. If, after attempting to transmit the geo-coordinates in digital form, the terminal determines that the cellular switching system is not capable of accepting this information, a light 314 is illuminated on the terminal. Once a connection has been established to an agent at a Public Safety Answering Point (PSAP), and the user has been alerted of the failed digital transmission of the geo-coordinates by light 314, the user can transmit the geo-coordinate information directly to the PSAP (in voice form as audio information or digitally) by actuating the

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location button 307. Thus, Grimes' location button 307 serves as a back-up means for conveying geo-coordinates directly to the PSAP when the primary automatic digital transmission of this information is not properly received due to a lack of capability within the cellular switching system.

Grimes' location button 317 is not an enable/disable switch that selectively enables and disables transmission of position information, as required by claim 49. As explained at column 6, lines 54-66, Grimes' cellular terminal always transmits the geo-coordinates in digital format to the cellular switching system when a 911 call is made. Grimes' location button does not and cannot disable or prevent this transmission: the geo-coordinates are transmitted regardless of state of the location button. In fact, because Grimes' location button is a back-up device, it does not even come into use until after the geo-coordinates have been transmitted and it is subsequently determined that the geo-coordinates were not properly received; thus, the location button cannot possibly disable transmission of position information, as required by claim 49. Grimes' location button merely provides an alternative mechanism for transmitting position information, once the position information has already been transmitted. However, this back-up or secondary transmission does not override or eliminate the original transmission of the geo-coordinates and certainly does not disable Grimes' terminal from making the initial transmission of geo-coordinates.

Moreover, it would not have been obvious to incorporate Grimes location button into Ohta's mechanism. Ohta discloses a map displaying system. Position data is collected by Ohta's vehicle and transmitted to a remote key station that supplies related map data to the vehicle in return. The mechanism described by Ohta's for conveying position information to the key station is plainly more suitable to Ohta system than anything disclosed by Grimes. Moreover, Grimes' location button serves to directly transmit geo-coordinates to a human operator at a PSAP in audio form when the preceding digital transmission of the geo-coordinates was improperly received due to a lack of system capability to process such digital signals. Such a button has no purpose in Ohta's system. Ohta's key stations are designed to understand the position information sent by Ohta's mobile devices; thus, an audio back-up system is unnecessary. Moreover, Ohta's mapping system is never

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connected to a human operator for listening to audio position coordinates and manual retrieval of map data; thus, there is no context whatsoever in Ohta's system for a location button such as that disclosed by Grimes. For all of the foregoing reasons, claim 49 would not have been (and could not have been) obvious from any combination of the cited references.

With particular regard to dependent claim 54, the Examiner further cites Smith for a teaching of a user interface. Even assuming, *arguendo*, that Smith teaches what the Examiner alleges and that it would have been obvious to modify the combination of the other *five* references with Smith as proposed by the Examiner, like the other five references, Smith does not disclose or suggest the requirements of claim 48 (i.e., a position reporting enabling unit configured to selectively enable and disable transmission of the position information). Consequently, Smith does not make up for the deficiencies of these other references and the subject matter of parent claim 48 and dependent claim 54 would not have been (and could not have been) obvious from any combination of these references. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 54.

Applicant has added new claims 55-64 which depend ultimately from independent claim 3. All of these claims should be patentable over the prior art of record for at least the reasons set forth above. Claim 55 recites a receiver configured to receive position signals and a processor coupled to the receiver and responsive to the position signals to determine the present position information indicative of a present position of the mobile communication device. Claim 56 further requires the receiver to be a global positioning system (GPS) receiver, and claim 57 further requires the present position information to be position coordinates. Claim 58 requires that the processor periodically determine the position information from position signals received by the receiver, and that the means for sending periodically transmit the position information over the bi-directional wireless link. Claim 59 requires the processor to periodically update the position information in accordance with a refresh interval. Claim 60 recites a receiver configured to receive position signals, wherein the present position information comprises the position signals. Claim 61 further requires an output

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means for providing the position-related information to the mobile user. Claim 62 further requires a position reporting enabling unit configured to selectively enable and disable transmission of the position information while the mobile communication device is operational. Claim 63 requires the input device to receive a plurality of selection signals, and requires the means for sending to send the plurality of selection signals over the bi-directional wireless link. Claim 64 requires the mobile communication to be a portable computing device. Support for claims 55-64 is found throughout Applicant's specification.

Further, Applicant has added new independent claim 65, which sets forth a method of receiving position-related information via a mobile communication device. Dependent claims 66 and 67 further limit claim 65 with respect to reception and processing of position signals. The steps of claim 65 are analogous to the elements of claim 3; accordingly, claims 65-67 should be patentable over the prior art of record for at least the reasons set forth above in relation to claim 3.

New independent claim 68 sets forth a mobile communication device for use by a mobile user, which includes: an input device configured to receive from an operator a selection signal indicative of a topic of interest; means for sending the selection signal over a bi-directional wireless link and for receiving position-related information that is a function of a present position of the mobile communication device and the selection signal; and output means for providing the position-related information to the mobile user. Similarly, new independent claim 69 sets forth a method of receiving position-related information via a mobile communication device, comprising: supplying a selection signal indicative of a topic of interest to the mobile communication device; sending the selection signal over a bi-directional wireless link from the mobile communication device; and receiving over the bi-directional wireless link position-related information that is a function of a present position of the mobile communication device and the selection signal. Like claim 3, these claims require that the position-related information received over the wireless link be a function of both the present position of the mobile communication device and the selection signal; thus, these claims should be patentable over the prior art of record, as discussed in detail above. Support for

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these claims is found in Applicant's specification, in particular, on page 36, line 8 through page 37, line 8.

Finally, new independent claim 70 sets forth a mobile communication device for use by a mobile user, which includes: means for establishing a bi-directional wireless link; means for sending present position information over a bi-directional wireless link; means for receiving position-related information that is a function of the present position information and at least one user-selected topic of interest; and output means for providing the position-related information to mobile user. Dependent claims 71-86 contain limitations similar to those found in the claims depending from claim 3. Like claim 3, the requirement of claim 70 of receiving position-related information that is a function of the present position information and at least one user-selected topic of interest is not disclosed or suggested by any one or combination of the documents relied upon by the Examiner; accordingly, claim 70 and its dependent claims should be allowable for reasons stated above.

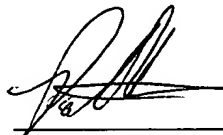
In view of the foregoing, Applicant respectfully requests the Examiner to find the application to be in condition for allowance with claims 3, 4, 8-14, 16-23 and 48-86. However, if for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is respectfully requested to call the undersigned attorney to discuss any unresolved issues and to expedite the disposition of the application.

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Applicant previously paid for a total of 52 claims and 5 independent claims (see the Preliminary Amendment filed May 14, 2002). Presently, there are 56 total claims and 6 independent claims pending; thus, an excess claim fee of \$78.00 (small entity, 1 excess independent claims and 4 excess total claims) is enclosed. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 05-0460.

Respectfully submitted,



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